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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/090,658	03/05/2002	Robert H. Mahoney		6109

7590

03/11/2004

Salvatore J. Maiorino  
827 Hylan Blvd.  
Staten Island, NY 10305

EXAMINER
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ELKINS, GARY E

ART UNIT	PAPER NUMBER
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3727

DATE MAILED: 03/11/2004

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Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/090,658

Applicant(s)

MAHONEY ET AL.

Examiner

Gary E. Elkins

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 15 December 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 March 2002 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Election/Restrictions***

1. In view of Applicant's admission that the species as defined in the requirement are not patentably distinct from each other as a result of the location of the mounting holes, and in view of the indicated allowability of claim 13, the election of species requirement is withdrawn and all the claims have been examined.

### ***Specification***

2. The abstract of the disclosure is objected to because the legal phraseology "Means" was set forth in line 4. Correction is required. See MPEP § 608.01(b).

### ***Drawings***

3. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the lid for covering the document holder as set forth in claim 22 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

### ***Claim Rejections - 35 USC § 112***

4. Claims 4-22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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In claim 4, line 6, "the outer edge of the bottom surface" lacks antecedent basis in the claims.

In each of claims 5 and 21, the preamble is unclear with respect to how the previous claim is directed to an ETC tag. Also, these claims are unclear since, by definition, a dependent claim must include all the limitations of the parent claim(s). The preambles in claims 5 and 21 do not appear to include the holder of the parent claim(s). It is assumed for the purpose of applying the prior art that claims 5 and 21 are attempting to further define the holder of the parent claim(s). However, correction is required.

In claim 21, "the panel" (two occurrences) is unclear with respect to which of the previously claimed plurality of panels is being referred to.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1-3 are rejected under 35 U.S.C. 102(e) as being anticipated by Brincat. Brincat discloses an ETC tag holder including an open top hollow body 12, 17 with a bottom surface 12 receiving the bottom of the tag 42. The mounting means 24, 30 is considered adjustably rotatably mounted insofar as claimed.

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7. Claims 1-5, 9, 12 and 21 are rejected under 35 U.S.C. 102(b) as being anticipated by DeVito. DeVito discloses an ETC holder including a hollow body 12 with a bottom surface at the lower end as depicted in fig. 2. With respect to claim 12, no distinction is seen between the mounting means 20, 28 of DeVito and that claimed as a result of the intended use with a motorcycle, i.e. the mounting means of DeVito is considered capable of being mounted on a motorcycle. With respect to claim 21, the clip 66 is considered a panel insofar as claimed.

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over DeVito in view of Moore. DeVito discloses all structure of the claimed holder except selection of lucite as the plastic material of the holder. Moore teaches that it is known to make a holder from lucite to facilitate viewing of the contents. It would have been obvious to make the holder of DeVito from lucite as taught by Moore since lucite facilitates viewing of the tag and is readily available and cost effective as a plastic material. Also, lucite is well known as an aesthetically pleasing material due to the smooth shiny exterior surface of the material.

10. Claims 18, 23 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over DeVito in view of Schumer. DeVito discloses all structure of the claimed holder except a finger slot. Schumer teaches that it is known to make a holder with a finger slot to facilitate removal of

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the contents. It would have been obvious to make the holder of DeVito with a finger slot as taught by Schumer to facilitate easier removal of the ETC tag from the holder.

11. Claims 19, 20, 22, 25 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over DeVito in view of Morris. DeVito discloses all structure of the claimed holder except a lid covering the holder or, with respect to claim 22, covering the document holder. Morris teaches that it is known to make a holder with a lid covering the contents of the holder. It would have been obvious to make the holder of DeVito with a lid covering the contents of the holder as taught by Morris to protect the contents. Lids are well known in this art.

***Allowable Subject Matter***

12. Claims 6-8, 11 and 13-17 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

***Conclusion***

The remaining cited prior art is illustrative of the general state of the art.

In order to reduce pendency and avoid potential delays, Technology Center 3700 is encouraging FAXing of responses in Office Actions to (703)872-9306. This practice may be used for filing papers not requiring a fee. It may also be used for filing papers which require a fee by Applicants who authorize charges to a PTO deposit account. Please identify the Examiner and art unit at the top of your cover sheet.

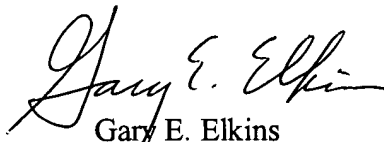
If in receiving this Office Action, it is apparent that certain documents are missing, e.g. copies of references cited, form PTO-892, etc., requests for copies of such papers should be directed to Errica Bembry at (703)306-4005.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist at (703)308-1078.

Any inquiry concerning this communication or earlier communication from the Examiner should be directed to Gary Elkins at telephone number (703)308-1034. The Examiner can normally be reached Monday through Thursday.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Mr. Lee Young can be reached at (703)308-2572.

  
Gary E. Elkins  
Primary Examiner  
Art Unit 3727

gee  
07 March 2004